



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,572	11/30/2001	Shinichiro Choji	50195-286	3795

7590 12/09/2004

MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

MEREK, JOSEPH C

ART UNIT	PAPER NUMBER
----------	--------------

3727

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,572

Applicant(s)

CHOJI ET AL.

Examiner

Joseph C. Merek

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/8/04.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 and 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/25/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 20 and 22, it has not been adequately disclosed that there is an adhesive layer between the first part and the second part where the adhesive layer is formed from the paint. The only reference in the written description regarding adhesive for the elected embodiment is found on page 5 in the second paragraph: "A firmly adhesive layer is formed between the powder coating and the foot portion 4a by the heat treatment. Because the tank body melt together while the powder coating an adhesive layer remains the bonding strength between the foot portion and the tank body is stronger than that obtained when the foot portion 4a is directly insert-molded in the tank body". There is no further description of the adhesive. The paint is claimed as being the same material as the plastic of the first part in claim 1 from which 20 depends. It has not been disclosed that the plastic material is an adhesive. This is a new matter rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3727

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 20 and 22, it has not been adequately disclosed that there is an adhesive layer between the first part and the second part where the adhesive layer is formed from the paint. The only reference in the written description regarding adhesive for the elected embodiment is found on page 5 in the second paragraph: "A firmiy adhesive layer is formed between the powder coating and the foot portion 4a by the heat treatment. Because the tank body melt together while the powder coating an adhesive layer remains the bonding strength between the foot portion and the tank body is stronger than that obtained when the foot portion 4a is directly insert-molded in the tank body". There is no further description of the adhesive. It is not clear if applicant is reciting that the paint is the adhesive. It is not clear what is being claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

Art Unit: 3727

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kasugai et al (US 5,104,472). Regarding claim 1, as it is best understood, as seen in Fig. 7, the insert part 21 has coatings 23 and 15 both of which cause the insert to bond to the tank wall P. The first part is the tank P and the second part is the insert 21, which is insert-molded in the first part. The paint limitation does not require any structure that is not in the reference. 23 and 15 both coat part 21 and satisfy the limitation of paint. P and 23 are made of the same material. Regarding claim 2, the process step of powder coating does not require any structure that is not in the reference. Regarding claim 3, the second part is heat treated when the container P is blow molded since it requires heating of the mold as seen in Col. 4, lines 4 and 5. Regarding claim 4, the first part is made of resin and the second part is made of metal as seen in Fig. 7 and Col. 3, line 53. See Col. 3, lines 8 and 9 where the body portion 3 (i.e. the parison P) and the tubular member 20 are made of a polyamide. Regarding claim 10, it is inherent that the melting temperature of the coating 15 is lower than that of the polyamide.

Claims 1-4 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Prince (US 6,189,744). Regarding claim 1, see Fig. 1 a where the insert part 1 is a part that is coated with plastic to increase the bond between part 1 and plastic tube 8. The coating and the plastic of part 8 are the same material. The paint limitation does not require any structure that is not in the reference. Regarding claim 3, the second part 1 is heat treated during the induction heating of the second part to bond the part 1 to the

Art Unit: 3727

first part 8. Regarding claim 4, the first part 8 is made of polyethylene and the second part 1 is a metal. Regarding claim 10, see page 6 where the first part 8 (the bag or tube) can be made of multiple layers which includes materials that have a higher melting point than the polyethylene.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Pachciarz et al (US 6,435,365). Regarding claim 1, as it is best understood, both the material of the tank and that of encapsulated ring are both plastic and therefore satisfy the limitation. Regarding claim 2, the process limitation of powder coating does not require any structure that is not in the reference. Regarding claim 3, encapsulated ring is heat treated during the molding process. Regarding claim 4, the first part the tank is plastic and the second part the ring 22 is metal.

Claims 1-4 and 10, and 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Suehiro Atsuo (JP 06-234163). The reference discloses the claimed invention.

Response to Arguments

Applicant's arguments filed 3/10/04 have been fully considered but they are not persuasive. Applicant argues that the structures of Kasugai et al and Pachciarz et al are not coated with a paint that is the same material as that of the first part. Moreover, the tube 20 of Kasugai et al is coated with the same plastic material as that of the first part. The paint does not require any structure that is not in the final product. Applicant continues to argue that the insert mold is structure. What applicant is missing is that the molds are not found in the final molded product, which is what is being claimed. Unless

Art Unit: 3727

the process imparts structure to the final product that is not found in the applied references, then the references anticipate the claim. Applicant does not submit any evidence as to the structure that is provided by the insert mold.

Applicant also argues that the coating must be continuous. This limitation is not required by the claims. Moreover, there is no support in the written description that the coating is continuous.

Therefore the examiner has maintained the previous rejections.

Applicant's arguments with respect to claims 1-4, 10, and 20-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Since the IDS 10/25/04 was filed during the period set forth in 37 C.F.R. 1.97(c), this action has been made final as set forth below. See MPEP 706.07(a).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

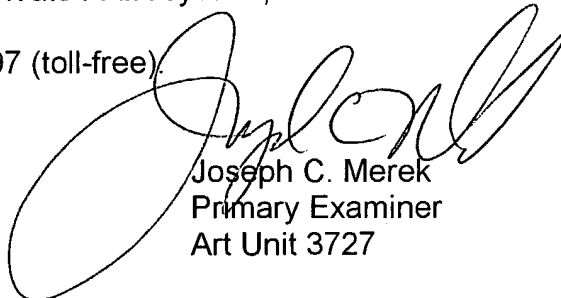
Art Unit: 3727

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C. Merek whose telephone number is 571 272-4542. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (571) 272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph C. Merek
Primary Examiner
Art Unit 3727